

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Goulmy et al.

Serial No.: To be assigned

Filed: March 2, 2004

For: THE HA-1 ANTIGEN

Examiner (presumed): P. Huynh

Group Art Unit (presumed): 1644

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PETITION FOR A RETROACTIVE LICENSE
UNDER 35 U.S.C. § 184

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The applicants hereby petition for a retroactive license under 35 U.S.C. § 184 in accordance with 37 C.F.R. § 5.14(a) for the above-referenced US application.

The applicants request retroactive foreign filing licenses for the following applications:

Foreign Country	Filing Date	Application Number (Patent Number)
European Patent Office	July 23, 1997	EP 97202303.0
Netherlands	July 23, 1998	PCT/NL98/00424
Japan	July 23, 1998	JP19982000504165 (JP2001510851T2)
European: Austria, Belgium, Switzerland, Germany, Denmark, Spain, France, United Kingdom, Greece, Ireland, Italy, Liechtenstein, Luxembourg, Monaco, Netherlands, Portugal, and Sweden	July 23, 1998	EP1998000936758 (EP0996636)
Australia	July 23, 1998	AU1998199885640 (AU8564098A1)
Australia	July 23, 1998	AU1998199885639 (AU8563998A1)
Australia	July 23, 1998	AU1998000085639 (AU0756962B2)

The first filing is the priority document, EP 97202303.0, filed July 23, 1997, now abandoned. Within one year of the priority document, an international PCT application was filed, PCT/NL98/00424, on July 23, 1998, designating all of the member states and regional offices. The Japanese, European and Australian patents referenced herein represent national entries of the PCT application.

A declaration by Dr. Victor H. Engelhard is attached herewith, avering to diligence in obtaining the retroactive foreign filing license. A declaration by Dr. Donald F. Hunt is also attached.

Pursuant to 37 C.F.R. § 5.25(a)(3)(ii) and (iii), the foreign filing of the priority document and the international PCT application, as well as the national entries effected from the international filing, were prepared and filed by the Assignee, Rijksuniversiteit te Leiden, a University in the Netherlands, through European counsel, who were unfamiliar with US Patent Law and the requirement of a foreign filing license. Therefore, until the international application entered the United States Patent and Trademark Office (USPTO), there was no knowledge of the pertinent law and facts (Patent Office Rules and Practice Rule 1.14, section VII) (copy attached). Thus, the possible need for a foreign filing license did not become apparent to the Applicants until at least the entry of the application into the USPTO (*In re Application* filed November 22, 1952, 837 O.G. 1046, 153 U.S.P.Q. 410 (Comm'r Pat. and Trademarks 1967)), which explains why the material was filed abroad (in the Assignee's and an inventor's home country) through error and without deceptive intent, without the required license (37 C.F.R. § 5.25 (a)(3)(iii)).

It is submitted that diligence in obtaining a retroactive foreign filing license is shown by filing the present Petition for a Retroactive License concurrently with the above-referenced continuation application. Furthermore, negotiations involving issues surrounding ownership of the invention were ongoing since filing of the parent application, i.e., US Ser. No. 09/489,760. The ownership issue evidently precluded or hindered the ability to determine if a foreign filing license was, in fact, required or the proper parties who should apply for such a license. In particular, if the parties from the U.S. were not co-inventors, then no foreign filing license would be necessary.

As indicated in the attached declaration, the potential need for a retroactive foreign filing license and a declaration were inadvertently not communicated to the inventors. Upon learning of the possible need for a foreign filing license, the inventor, Dr. Victor H. Engelhard, diligently executed the attached declaration.

Pursuant to 37 C.F.R. § 5.25(a)(3)(ii), the present petition for a retroactive filing license is being filed concurrently with the above-referenced continuation application. Thus, the

resolution of the foreign filing license is being sought concurrently with the filing of the above-referenced continuation application and before the grant of a U.S. Patent resulting from the above-referenced continuation application "in order that the status of the patent may be known with certainty" (Patent Office Rules and Practice Rule 14, section V, citing *Beckman Instruments, Inc. v. Coleman Instruments, Inc.*, 143 USPQ 278 (7th Cir. 1964)). Applicants submit that under the circumstances of the present case, for example, resolution of ownership and inventorship, as well as, representation by the assignee, the Rijksuniversiteit te Leiden, through European associates, diligent efforts have been pursued in obtaining a retroactive foreign filing license.

Respectfully submitted,



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Date: March 2, 2004
AFN

Enclosures: Declaration of Donald F. Hunt
Declaration of Mr. H. Engelhard
Rule 14